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W. Layman
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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IN RE APPLICATION OF: :
TOMOKO TERAKADO ET AL : EXAMINER: KOENIG, ANDREW Y.
SERIAL NO: 09/114,352 :
FILED: JULY 13,1998 : GROUP ART UNIT: 2611
FOR: RECEIVING APPARATUS AND :
METHOD, TRANSMITTING :
APPARATUS AND METHOD, AND :
TRANSMISSION MEDIUM :

RECEIVED
FEB 27 2003
Technology Center 2600

REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

This communication is responsive to the Official Action dated November 5, 2002.

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-14 are presently active in this case.

In the outstanding Office Action, Claims 1, 4, and 7-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hamilton et al (U.S. Pat. No. 5,579,055) in view of Terasawa et al (U.S. Pat. No. 6,147,714).¹ Claims 11-14 were rejected under 35 U.S.C.

¹Examiner Koenig indicated by telephone on February 25, 2003 that there was no outstanding rejection under 35 U.S.C. §102(b) as inadvertently stated in numbered paragraph 4 in the outstanding final Office Action.

§103(a) as being unpatentable over Davis et al (U.S. Pat. No. 5,559,548) in view of Teresawa et al. Claims 2, 3, and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hamilton et al and Teresawa et al in view of Davis et al.

The outstanding Office Action acknowledges that Hamilton et al are silent on a broadcaster adding electronic program guide information (EPG) data and generating an image signal.² The outstanding Office Action indicates that Teresawa et al disclose a system where a broadcaster adds EPG data and simultaneously encodes image signals.³ The outstanding Office Action then asserts that it would have been obvious to one of ordinary skill in the art to modify Hamilton et al by using a broadcaster that adds EPG data while simultaneously generating image signals as taught by Teresawa et al in order to simultaneously send information along with the programming and thereby efficiently using the available bandwidth.⁴

Applicants respectfully traverse this assertion of obviousness. Firstly, there are no bandwidth considerations disclosed in Teresawa et al. Secondly, Applicants submit that a broadcaster adding EPG data to a generated image signal would consume available video bandwidth. For example, Hamilton et al disclose that text data service provided by text data service suppliers *waste valuable video bandwidth* and is *undesirable*.⁵ Indeed, Hamilton et al avoid wasting valuable video bandwidth in that:

... the EPG data is formatted into transactions including display commands and the like so that the EPG data may be transmitted directly to the viewer's television tuner

²Office Action, page 3, line 9.

³Id., page 3, lines 10-11.

⁴Id., page 3, lines 12-16.

⁵Hamilton et al, column 1, lines 24-33.

as data *rather than video*, thereby saving a substantial amount of bandwidth.⁶
[emphasis added]

Thus, the suggestion in the Office Action that such a combination will efficiently use available bandwidth is a suggestion not found in the applied prior art as required by M.P.E.P. §2143. Moreover, the primary prior art reference of Hamilton et al teaches away from the combination asserted in the Office Action. M.P.E.P. §2145 indicates that it is improper to combine references where reference teaches away from their combination.

Therefore, it is respectfully submitted that the asserted combination of Hamilton et al and Teresawa et al is improper, and not combinable. Hence, independent Claims 1 and 8-10 and Claims 2-7 which depend directly or indirectly from Claim 1 patentably define over the applied prior art.

Regarding the rejection of independent Claims 11-14 under 35 U.S.C. §103(a) as being unpatentable over Davis et al (U.S. Pat. No. 5,559,548) in view of Teresawa et al, the outstanding Office Action acknowledges that Davis et al are silent on a broadcaster adding electronic program guide information (EPG) data and generating an image signal.⁷ As before, the outstanding Office Action indicates that Teresawa et al disclose a system where a broadcaster adds EPG data and simultaneously encodes image signals.⁸ The outstanding Office Action then asserts that it would have been obvious to one of ordinary skill in the art to modify Davis et al by using a broadcaster that adds EPG data while simultaneously generating image signals as taught by Teresawa et al in order to simultaneously send information along with the programming and thereby efficiently using the available

⁶Hamilton et al, column 1, lines 64-67.

⁷Office Action, page 4, lines 17-18.

⁸Id., page 4, lines 18-20.

bandwidth.⁹

Applicants also respectfully traverse this assertion of obviousness. Like Teresawa et al, there is no discussion in Davis et al of bandwidth considerations. Thus, the suggestion in the Office Action that such a combination will efficiently use available bandwidth is a suggestion not found in the applied prior art as required by M.P.E.P. §2143. Moreover, Davis et al disclose that there is a particular need for a *flexible program schedule system* that will allow a *cable operator* to broadcast full screen displays of program schedule information as well as partial screens of program information together with promotional and other commercial information.¹⁰ However, by combining the electronic program schedule system of Davis et al with the broadcaster of Teresawa et al which simultaneously adds EPG data to the image data, the electronic program schedule system of Davis et al is rendered unsatisfactory for its intended purpose of providing a flexible program schedule system to the cable operator. For example, having EPG information added by the broadcaster of the image signal, who accordingly has control of the programming schedule, would make any change to the EPG data by the cable operator erroneous. M.P.E.P. §2143.01 indicates that a proposed modification can not render the prior art unsatisfactory for its intended purpose.

Thus, it is respectfully submitted that the asserted combination of Davis et al and Teresawa et al is improper, and not combinable. Hence, it is respectfully submitted that Claims 11-14 patentably define over the applied prior art.

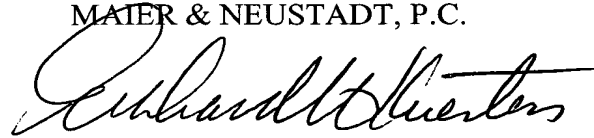
⁹Office Action, page 4, line 20, to page 5, line 2.

¹⁰Davis et al, column 3, lines 3-8.

Consequently, in view of the above discussions, the outstanding grounds for rejection are believed to have been overcome. This application is believed to be in a condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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